

No. 791

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

AMERICAN SALES BOOK COMPANY (A
CORPORATION) AND WARREN F. BECK,
Plaintiffs in Error,

vs.

JOSEPHUS BULLIVANT, JR.,
Defendant in Error.

Brief of Plaintiffs in Error.

T. J. GEISLER,
Attorney for Plaintiffs in Error.

**In Error to the Circuit Court of the United
States for the District of Oregon.**

UNION PRINTING CO., 84-86 FOURTH STREET, PORTLAND, ORE

FILED

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Brief of Plaintiffs in Error.

This is a Writ of Error directed to the United States Circuit Court for the District of Oregon, to review its proceedings and final judgment in an action brought to recover damages for the infringement of letters patent for an invention. The judgment was for defendant, because the Circuit Court adjudged the patent void, for lack of patentable novelty of the invention involved.

STATEMENT OF THE CASE.

The patent involved was granted to Warren F. Beck of the plaintiffs in error April 24, 1900, No. 647,934, for an improvement in Manifolded Sales Books. A copy of the patent marked Plaintiffs' Exhibit "A," will be found following page 38 of the transcript.

The interest of the American Sales Book Company in the patent in question is founded on an agreement with the Plaintiff Beck, as set forth in the amended declaration (Trans., p. 15) and

admitted in the second paragraph of the Stipulation of Facts (Trans., p. 27), by which the plaintiff company was granted the exclusive right to manufacture the said patented invention.

Manifolding Sales Books are commonly used in stores for taking down, in duplicate, a memorandum of a sale, or order, so that one copy of such memorandum may be delivered to the purchaser, and the other retained as a record of the transaction.

In their general construction, these books comprise an outer cover, a pad of paper, and a carbon sheet to be arranged between any pair of leaves; the leaves of the pad being generally imprinted with a blank form, and numbered in pairs, progressively; one leaf of each pair being the original and the other intended to receive the carbon copy of the memorandum made. At the time of the advent of Beck's invention, manifolding sales books had been in use for a number of years in various forms. The carbon sheet of the earlier styles of books was loose; but this being inconvenient, in the later styles the carbon sheet was attached to the pad or its cover, so that it could not fall out of place. There, however, still remained a serious inconvenience. Whenever the old style book was used, the carbon sheet had to be handled with the fingers. This would soon soil the fingers, and consequently was a source of annoyance. Furthermore, each use of the old style books necessitated three operations: First, the top leaf of the pad, covering the carbon sheet had to be thrown back; second, the carbon sheet had to be lifted by the fingers so as to be able to get at the underlying leaf; and third, the underlying leaves of the pad had to be rearranged. Thus, the required individual lifting of the carbon sheet was not only an annoyance, but also an inconvenience.

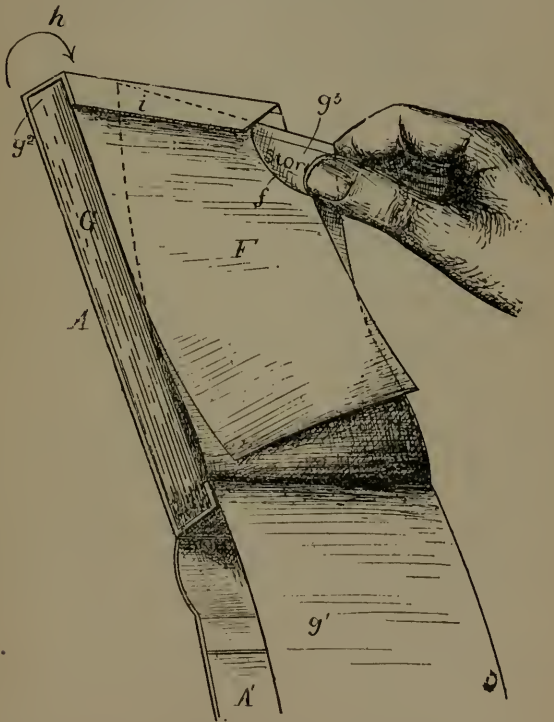
At this stage Plaintiff Beck invented his improvement. And, as such invention is to be considered here, the particular improvement or beneficial effect achieved by Beck in manifolding sales books, was that the carbon sheet is so constructed and combined with the pad, that the individual leaves of the pad may be readily and conveniently withdrawn from under the carbon sheet without

lifting, or otherwise handling the latter. (See lines 19-32, p. 2 of Specification of Letters Patent, following p. 38 of Transcript.) This desirable result had never before been obtained by any practical means. (See 7th Finding of Fact, Trans., p. 32).

The means by which Beck accomplished this result are amply described and illustrated in said Letters Patent. But for the convenience of the Court, they will be here recapitulated.

These means, and the combination and arrangements of the co-operating parts will be seen in the following—

Illustration No. 1 of Plaintiff's Exhibit "B."



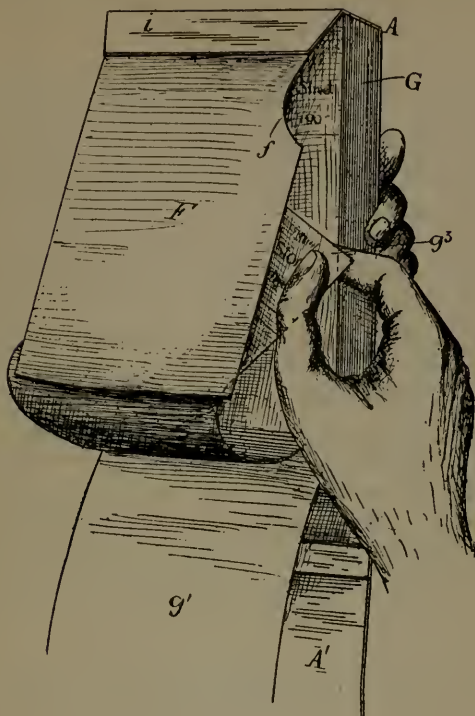
[NOTE.—There is a discrepancy in the record between the marks used for identifying the exhibits of the parties, as appear-

ing in the Stipulation of Facts (Trans., p. 27), and in the Bill of Exceptions (Trans., p. 36). To make such marks agree, "Plaintiff's Exhibit 'B'" referred to in the fourth paragraph of the stipulation should read "Plaintiff's Exhibit 'C.'" And "Defendant's Exhibits 'A' and 'B'" referred to in the sixth paragraph of such stipulation should read "Defendant's Exhibit 'B'" and "Defendant's Exhibit 'C.'"]

The foregoing is a pictorial reproduction of the Exhibit "B" of plaintiffs, referred to in the Bill of Exceptions (Trans., p. 36). It shows a sample of the manifold sales books manufactured and sold by the Plaintiff Company; the same embodying the particular combination or features patented to Beck with which we have to deal.

Referring to the illustration, and the reference characters thereof: A, A' represent an outer cover, or holder, of convenient style for the pad G. The leaves of the pad are fastened together at their lower ends. In the illustration, the uppermost leaf, g'—which we will suppose is an original memorandum leaf—is turned back so as to disclose the carbon sheet, F, resting on the duplicate memorandum leaf. The carbon sheet, F, is fastened at its upper end, and in such manner as to overlap the free ends (g₂) of the leaves of the pad, as indicated by the arrow, h. The upper right-hand corner, f, of the transfer sheet, F, is cut away and thus exposes the corner (g₃) of the underlying leaf, the remainder of which is covered by the carbon sheet, and the exposing of the corner, g₃, of the underlying leaf operates to allow the latter, when to be withdrawn, to be conveniently seized and manipulated by the hand as shown. The next movement of the hand is shown in

Illustration No. 2 of Plaintiff's Exhibit "B."



Thus, in using the Beck book, only two operations are required. The annoying and inconvenient second operation described above with respect to prior styles of books—the individual lifting of the carbon sheet—was eliminated. In the Beck book the withdrawal of the underlying leaf, g_3 , was readily accomplished by pulling the same a trifle to one side, as shown in the first of the foregoing illustrations, and then drawing such leaf from under the carbon sheet, as shown in the second illustration, *without in any wise having to handle such carbon sheet.*

Upon the underlying sheet (g_3) and the next following original leaf too, having been withdrawn, the carbon sheet would

naturally fall back into position; and then, upon the withdrawn original leaf having been laid back upon the carbon sheet, the book is again ready for use.

It must also be noted from the foregoing illustration No. 2 that there is but little lifting of the transfer sheet, while withdrawing an underlying leaf of the pad. Observe further that the construction and arrangement, or combination, of the pad and the transfer sheet allows the holder therefor to be provided with the shield, *i*, without in any manner interfering with the described manipulation of the pad. This feature, while not described or claimed in the specification of the invention, nevertheless is a desirable feature rendered possible by the particular combination invented by Beck. The provision of the protecting shield, *i*, is of much advantage, when the pad is to be used out of doors. Under such circumstances it would protect the hinge-end; that is to say, the fastened end of the carbon sheet. The importance of this feature was testified to by witness Frank Strauhal. (Trans., p. 37). Attention will further be called thereto when discussing comparatively the merits of the invention in question, and the type of manifold sales book placed in evidence by the defendant.

The claims allowed in plaintiff's patent, covering the particular features above described, are 2 and 3. These read:

"2. The combination, with a manifold-pad, of a holder or cover therefor having a carbon or transfer sheet secured thereto, said transfer sheet being folded over upon the leaves of the pad at their free ends and having a portion cut away to expose a portion of the leaves at or near their free ends for the purpose set forth."

"3. The combination, with a manifold-pad, of a carbon or transfer sheet normally resting upon the top of the pad and overlying the leaves thereof, said transfer sheet having a portion cut away to expose a portion of said leaves at or near their free ends

for the purpose set forth, the leaves at their free ends being otherwise concealed by the transfer sheet."

The Defendant Bullivant keeps a grocery store in Portland, Oregon, and the infringement charged against him is predicated upon his wrongfully and unlawfully using duplicate sales books in his business, which books infringed the said claims of the plaintiffs' patent.

(Paragraph 4, Stipulation of Facts, Trans., p. 27; 6th Finding of Fact, Trans., p. 32.)

Of the existence of such patent defendant had personal knowledge, being informed thereof by plaintiffs' agent (see Testi. of C. H. Wilcox, Trans., p. 37). It may be said, however, that one W. H. Jarrett, doing business at Seattle, in the State of Washington, under the style of Ideal Duplicate Order Book Company, and who was the manufacturer of the infringing books, is the real litigant, as it were. Residing without the District of Oregon, he could not be made a party; but he nevertheless is fighting over the shoulder of defendant Bullivant.

There is no question of identity between the books used by the defendant as stated, and the Beck invention. That was conceded. Such was also the 6th Finding of the Circuit Court above referred to.

The only question to be determined was, whether the improvement for which the patent was granted to the plaintiff Beck was a new and useful *invention* as contemplated by law.

The case was tried before the Court without a jury, pursuant to said written Stipulation between the parties, and found on page 26 of the Transcript.

The Court made its special and separate Findings of Fact and law on the several issues presented, which will be found on page 29 of the Transcript, and on such Findings adjudged the patent invalid, and rendered judgment in favor of the defendant.

From said Findings of Fact, it will appear that there was no question as to the title of plaintiffs under their patent, or that the same had been issued in due form by the Patent Office.

On the question of *novelty* the trial Court found that the improvement of Beck was original and new. This is its finding:

"7. That prior to the discovery by said Warren F. Beck of such patented improvement in manifold sales book, no manifold sales books were made, used or known embodying such particular and patented features or improvements, to-wit, comprising a holder, or cover, and a pad on the top of which normally rests a carbon, or transfer-sheet, said sheet overlying the free ends of the leaves of the pad, and covering the leaf under it: and said transfer sheet having a portion cut away to expose a portion of said leaf under it near its free end, and facilitating the withdrawal of the same from under said transfer sheet, as in said patent described and claimed, and as shown in Plaintiffs' Exhibit 'B.' . . ." (Trans., p. 32.)

On the question of utility, the following Finding of the Court shows that said improvement was abundantly useful:

"10. That in accordance with said agreement between the plaintiffs, American Sales Book Company and Warren F. Beck, said American Sales Book Company has extensively practiced the said alleged patented invention, and manufactured, advertised and introduced throughout the United States manifold sales books embodying said alleged patented improvement; and that in the Northwestern States within the year ending about August, 1901, large quantities of manifold sales books embodying said alleged invention, to-wit: about 500,000 have been sold to merchants and others in said Northwestern territory, and are now in use in said territory." (Trans., p. 33.)

Note also in connection with this 10th Finding the evidence of witness ~~C.~~ C. H. Wilcox, the Pacific Coast Agent of the plain

tiff company. He, in testifying to the large number of the plaintiff's books now in use, said that *with few exceptions the merchants to whom the Beck book had been sold had re-ordered the same.*

The evidence of the defendant consisted entirely of the facts admitted by said Stipulation of Facts (Trans., p. 26) and certain exhibits. From an inspection thereof, it will be seen that in attempting to substantiate the defense, that Beck's invention was void for lack of patentable novelty, no manifolding sales book, or like contrivance, was offered in which there was to be found any *combination* even remotely resembling the combination patented to Beck. But instead, the defendant offered in evidence sundry *disconnected* and individual devices, in which, by *speculation and inference*, there was to be found certain features remotely suggestive of the form and action of the elements of Beck's combination regarded in their *individual* character.

And the defendant's Exhibit "A" was introduced merely to prove to the Circuit Court, that even if the combination invented by Beck be found to be original and new, yet the beneficial result achieved, that is to say, its utility was of no *sufficient* importance to sustain a patent granted therefor. Because a like effect was obtained in said Exhibit "A" of defendant. The construction of this book is illustrated on page 42 of this Brief, and will be later described. For the present it is immaterial. This book was the immediate predecessor of the Beck book. It had been in use for a considerable time before the introduction of the Beck book; and in a way this book allowed the leaf of the pad underlying the carbon sheet to be withdrawn without touching the latter with the fingers. Since there is no identity of construction claimed between this and the Beck book, its comparative merits will not be referred to for the present. This book the defendant insisted in the Court below was just as good as Beck's book, when considering the *modus operandi*.

But note, instead of staying with their alleged convictions, soon after the Beck book appears on the market, the defendant

and his manufacturer, Jarrett, throw over the just-as-good book, and make and use books after the principle of the Beck invention. The contention of defendant in support of the utility of his Exhibit "A" was purely verbal argument. He did not go on the stand and so swear. Since he used the Beck book himself; and apparently out of sheer preference, it would have been embarrassing to testify to the contrary. And so he judiciously kept away.

The Circuit Court disregarded in its Findings, the sundry exhibits of defendant, in the sense that it did not hold such exhibits to anticipate the combination of Beck. But, nevertheless, at the conclusion of the trial, the Circuit Court, being in *doubt* on the question of the patentable novelty of Beck's improvement and combination, *resolved such doubt against the patent* and gave judgment for the defendant. The remark of the Court in so disposing of the case is not of record; but the defendant's counsel will agree with me that its substance was: "I do not *think* that this invention is of *sufficient* importance to warrant the grant of a patent therefor." The said doubt of the Court was occasioned wholly, because the trial judge was unable to see, from his standpoint of judgment, any *superior* degree of utility in the Beck invention; in this respect adopting the defendant's contention. That this inference is correctly drawn is apparent from the 12th and last Finding of the Court, viz:—

"12. That the said alleged patented improvement offers no greater advantages or utility than the form of manifold sales books in use in the United States prior to said alleged patented invention, as shown by the evidence, defendant's exhibits, and stipulation herein."

The whole of the criticism of the Court below of Beck's invention is embodied in this 12th Finding; yet, the single fact which the Court marked thereby—the fact that, in the judgment of the Court, the Beck combination failed to present any *superior degree* of advantage or utility over the form of manifolding sales books previously used—the Court considered so vital, so strong

an indication of the lack of patentable novelty, of said combination and improvement of Beck, that the patent therefor granted must be declared void. In other words, the inference inevitably to be drawn from the context of said 12th Finding, is that the Court below erroneously assumed as a rule of law, controlling its decision on the question, as to whether the Beck improvement was the product of invention, that it must delicately poise the utility of the Beck book in comparison with pre-existing manifolding books; and if to the mind's eye of the Court the scale did not show the utility of the Beck improvement to be decidedly *greater* than that of the other devices, then the Court must find that the subject-matter lacks legal novelty, and that no patent granted therefor can be sustained.

It is further evident that in so weighing the *degree* of utility, and of the novelty of the Beck invention, the Court below *laid aside the weight of the opinions of the innumerable merchants who used the Beck book PRACTICALLY in their daily vocations*; also the weight of the judgment of the *expert examiner* of the Patent Office on the same subject, and the weight of the fact that the manufacturer of the defendant's infringing book, Jarrett, thought it wiser *to follow the plan of Beck's improvement* than to continue making and using the prior style of book, which, it is contended, is just as good as Beck's.

On the *facts* as found by the Court, the plaintiffs contended in the Court below that they were entitled to judgment as a matter of law. That whatever *doubts* the Court had on any question must be *resolved in favor of the validity of the patent*. That the grant of the letters patent was *prima facie* evidence of their validity, and the defendant had the burden of overcoming this presumption by convincing testimony.

That *novelty* and *utility* is all that the patent statutes require, as a condition for granting letters patent for any invention or discovery. That the *degree* of utility, or of novelty, or of invention was immaterial. So long as the invention did possess utility,

and novelty, and did require invention, in *some* degree, the requirements of the law were satisfied.

The plaintiffs also argued in the Court below that the act of the defendant in using books which copied all the features of the book patented to Beck estopped him from questioning the utility of the Beck book; because a man cannot deny the utility of a thing which he is actually using.

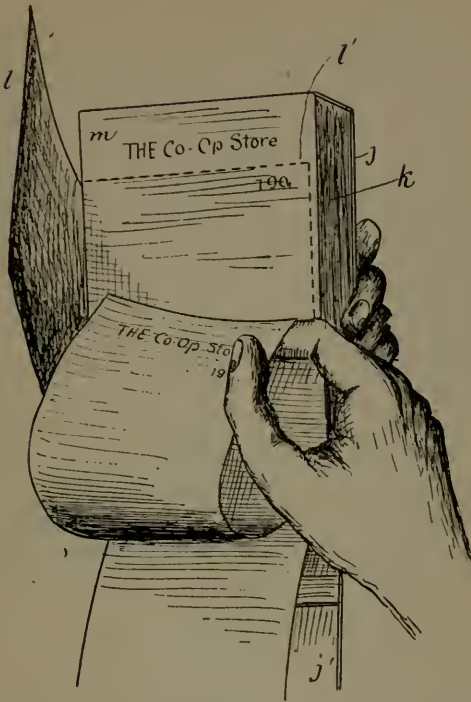
From what has been stated, it is apparent that the issues involved in this action are clearly marked. It will also appear that the defense did not rely on any *existing combination*, but on an imaginary one, which might possibly be built by *speculatively* uniting a number of distinct and disconnected devices. This deduction is apparent from the plea of the defendant (Trans. p. 20), and especially so from the character of the evidence introduced in support of such plea, to which evidence will briefly be referred.

The whole of such evidence consisted of the facts admitted in paragraphs 5, 6 and 7 in the Stipulation of Facts (Trans. p. 26), and of the defendant's Exhibits "A," "B" and "C." Of the paragraphs of the stipulation referred to, the only one which sets forth matter in any wise concerning the novelty of the invention patented to Beck is the fifth.

"5. That for many years prior to the application for the issuance of letters patent in question on the said invention, duplicate order books were in general use, the same having a carbon sheet, loose or secured in place, for transferring the memorandum of the order written on one sheet to a duplicate sheet or sheets arranged below. *But in none of such books did the carbon sheet have a corner cut away, or a thumbhole, for the purpose stated by said Beck in his specification of said invention forming a part of said patent.*"

When the case came up for trial, the only exhibit introduced by the defendant in amplification of the foregoing paragraph was defendant's Exhibit "A," which is reproduced in the following

Illustration No. 1 of Defendant's Exhibit "A."



This figure represents a type of manifold sales books, in the market prior to the plaintiff's book, and which, as mentioned, the defendant said was as good as the Beck book, but had nevertheless discarded. The book consists of a cover, *j*, *j'*, holding a pad, *k*, and transfer or carbon sheet, *l*. The latter is attached in any suitable way, so as to normally overlap one side of the pad, and rest on top of the same, as shown by the dotted outline of the transfer sheet, *l'*. The leaves of the pad are also fastened together at their bottom edges. When in its normal position, the transfer sheet leaves exposed the top portion of the underlying leaf, *m*, and this may be drawn to one side and seized with the

finger, so as to withdraw such leaf from under the transfer sheet. But note the effect of such operation. The act of withdrawing the underlying leaf causes the transfer sheet to be lifted to a perpendicular position by the edge of the leaf withdrawn scraping along the carbon sheet. Compare herewith the same manipulation of the Beck book, as shown in illustration No. 2 of plaintiff's Exhibit "B," p. 5.

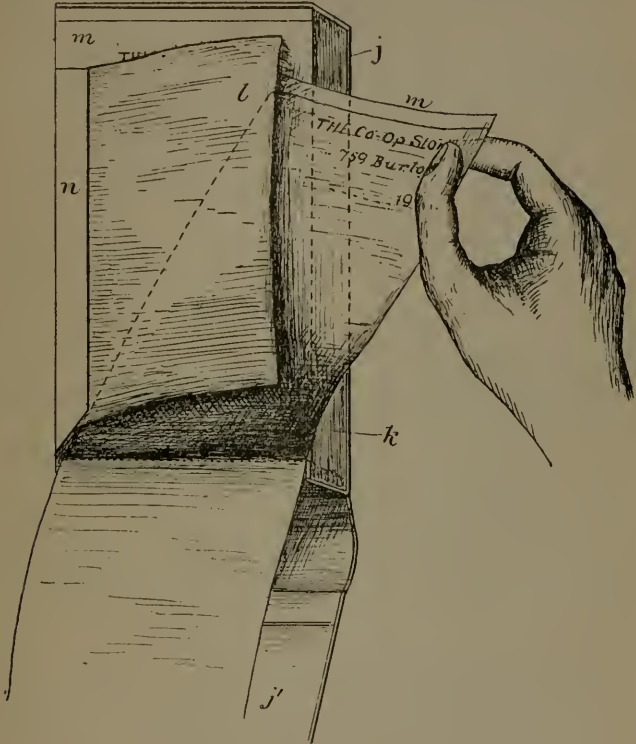
The comparison shows unquestionably that the transfer sheet of a book represented by defendant's Exhibit "A" necessarily receives much more wear than the Beck book.

Now, imagine both types of books being used out of doors in stormy weather. Observe that the Beck book, as apparent from Illustration No. 2 thereof, may be held close to the body, and that the back of the transfer sheet alone is exposed. The underside, or carbon face thereof, is never necessarily exposed. Contrasted herewith, observe that the transfer sheet of defendant's Exhibit "A" *must swing way out*, in order to allow the withdrawal of the underlying sheet of the pad. Thus, it becomes directly exposed to the weather, and that on its carbon face. Defendant's Exhibit "A" represents the style of book Strauhal Bros., grocers in Portland, Oregon, had used until Mr. Wilcox showed them one of the Beck books. (Trans. p. 37.) Then Strauhal Bros. adopted the latter. And why? "Because" (using Mr. Frank Strauhal's words, Trans. p. 38) "we liked them better. The carbon as arranged in plaintiffs' book is better protected, and is not apt to get wet along the edge, and to tear off, if used out of doors."

Observe further that the combination comprised in the Beck book allows the cover, or holder, A, thereof to be provided with a shield, i, to protect the hinge-edge of the carbon sheet, and that this shield in no wise interferes with the use of the book. See Illustrations Nos. 1 and 2 above of plaintiffs' Exhibit "B." Now contrast herewith the provision of a protective shield in the style of book shown by defendant's Exhibit "A."

The effect of such arrangement, if attempted, is shown in the following

Illustration No. 2 of Defendant's Exhibit "A."



n indicates the shield referred to. Note that, with the use of such shield, in order to be able to clear the leaves of the pad from the same, while arranging such leaves with respect to the carbon sheet, the leaf being withdrawn must be pulled way to one side. Certainly an awkward manipulation, exerting quite a strain on one corner of the leaf, and if at all hurriedly done, without having

quite cleared the edge of the leaf from the shield, the leaf will, obviously, be torn. And in placing an original leaf of the pad on the carbon sheet this may readily be done in the Beck book, the narrow end of the leaf will easily slip under the shield. But in defendant's Exhibit "A," provided with a shield, the leaf to be placed must be inserted sidewise under the shield, a most awkward and time-consuming operation. Yet the protective shield is of decided advantage. This very provision is one of the features that appealed to Mr. Strauhal, as is apparent from his said remark: "The carbon as arranged in plaintiffs' book is better protected, and is not apt to get wet along the edge, and to tear off, if used out of doors."

A further important benefit resulting from the particular arrangement of the carbon sheet in the Beck book is that such sheet is well adapted to bear, without tearing, any reasonable strain that may inadvertently be imposed upon it, while withdrawing an underlying leaf. The strain so imposed upon the carbon sheet would be downward, and thus directly in line with its greatest resistance. Not so, however, in the type of book shown by defendant's Exhibit "A." Here a like strain would cause a *side pull* on the upper corner of the carbon sheet against the *sharp edge* of the pad of leaves, thus presenting every condition favoring the tearing of the carbon sheet, if accidentally handled as mentioned. Yet, this handling it is liable to receive many times a day in busy stores. All these facts are self-evident.

Briefly describing the two remaining exhibits of defendant: The devices represented by defendant's Exhibit "B" merely show a blank book provided with intermediate transfer or carbon sheets; and the corners of the free ends of the leaves are cut diagonally, so as to project one below the other in steps, evidently for the purpose of facilitating the ready *opening*, or separating, of the leaves of the book at any place.

Defendant's Exhibit "C" shows the same feature in connection with unbound sheets of paper. These are the devices to which

defendant refers in the 6th paragraph of said Stipulation of Facts.

In the 7th paragraph of such Stipulation of Facts, reference is had to the fact that thumbholes are common in the index of ledgers and other books, for the purpose of facilitating the *opening* of the book at any certain page.

Beck's invention had nothing to do with facilitating the *opening* of the sales book at a certain place, manifolded sales books being not so handled.

These exhibits really had nothing to do with the case; and note, there was no finding by the trial Court that either of those book "opening" features were suggestions to Beck of his combination.

To the refusal of the trial Court to allow the motion of the plaintiffs for judgment in their favor, upon the said findings of the Court, the plaintiffs duly excepted; and such exception was allowed.

The plaintiffs also duly excepted to the said 12th finding of the Court as wholly unsupported by any evidence; and further, for the reason that such finding is wholly immaterial, and implies the application of an erroneous rule of law; and such exception was allowed.

And the plaintiffs further duly excepted to the conclusion of law found by the Court, and to the decision of the Court giving judgment in favor of the defendant, for the reason that the facts found were wholly insufficient to support said decision, or said conclusion of law, or said judgment; that the said decision and conclusion of law were wholly erroneous, and the granting of judgment to the defendant was contrary to the law in the premises. And said exception was also allowed.

And thereupon the plaintiffs duly filed their petition for a Writ of Error in order that the said errors of the Court below

might be corrected in this Court; and such Writ of Error was duly allowed.

Together with the plaintiffs' petition for said Writ of Error, the plaintiffs filed the following

ASSIGNMENT OF ERRORS.

1. Error of the Court in not finding as a conclusion of law that the letters patent issued to Warren F. Beck on the improvement in manifold sales books are *prima facie* evidence of their own validity.

2. Error of the Court in not finding as a conclusion of law that the *prima facie* validity of the said letters patent issued to Warren F. Beck has not been overcome.

3. Error of the Court in not finding as a conclusion of law that the burden of proof rested upon the defendant on his plea against the lack of novelty, and utility of the patented invention in question, and that every reasonable doubt must be resolved against the defendant in favor of the validity of the patent.

4. Error of the Court in not finding as a conclusion of law that the fact that the defendant did use manifold sales books which were identical with that of the book patented to Beck, is sufficient in itself to establish the utility of said patented invention as against the defendant.

5. Error of the Court in applying as a rule of law a comparative measurement of the advantages, or utility, of the manifold sales books patented to Beck with the sales books in use prior to said patented invention.

6. Error of the Court in not finding as a conclusion of law, upon the findings of fact of the Court, namely: That the patented invention of Beck was not known prior to its discovery by said Beck, and that said invention did possess utility in some degree; that the said patent was valid, and that the books used by the

defendant were an infringement of said patented invention, and the plaintiffs herein are entitled to recover.

7. Error of the Court in not finding as a conclusion of law, upon the facts found by the Court, namely: That the invention patented to Beck was extensively practiced; and that large quantities of manifold sales books embodying said patented invention have been sold, and are now in use; that such acceptance by the public is evidence of a high degree of the utility of the invention.

8. Error of the Court in not finding as a conclusion of law, upon the following facts found by the Court, namely: (1) That the improvement patented to Beck was not known, or in use, prior to its discovery by said Beck; (2) that said improvement did possess utility in some degree, and (3) that the improvement was readily adopted by the public, and manifold sales books embodying such patented improvement were extensively purchased by the public; that such facts were sufficient in themselves to sustain the novelty and utility of the improvement, and the validity of the patent.

9. Error of the Court in finding as a conclusion of law that, because the invention patented to Beck possesses no superior degree of utility over other and previously-existing forms of manifold sales books, therefore the patent issued to Beck is void for lack of novelty.

10. Error of the Court in applying as a rule of law that the novelty of said invention is to be ascertained by measuring its utility comparatively with prior devices for the same purpose.

11. Error of the Court in finding that the said patent issued to Warren F. Beck of plaintiffs is void for the lack of novelty.

12. Error of the Court in giving judgment in favor of the defendant in this case on the facts found by the Court.

13. Error of the Court in not giving judgment in favor of plaintiffs on the facts found by the Court.

14. Error of the Court in not finding that the patent to Beck in question is valid; that the defendant infringed the same, and that the plaintiffs are entitled to recover their damages and costs because of such infringement.

And on such Assignment of Errors the following main points arise:

ARGUMENT.

I.

That it is apparent from the face of the record of this case that the trial Court failed to recognize the *force* of the rule of law, that a patent for an invention is *prima facie* evidence of the existence of all the facts essential to its validity. And hereunder:

(a) That the force of this presumption in favor of patents for inventions is as potent as the presumption of the innocence of a person charged with crime.

(b) That the decision of the Patent Office on the question of the patentable novelty of the Beck invention is entitled to the highest respect, and that no proof was presented to the Circuit Court to justify the reversal of said judgment.

(c) That the patentee is entitled to the benefit of every doubt, and that the proof offered to overcome the presumption that the thing patented is the product of invention should not have been accepted as sufficient to satisfy or *convince* the mind against such presumption.

(d) That the patent statutes were enacted to reward industry; and, therefore, they are to be liberally construed, so as to protect the smallest invention like the greatest. That the law has no such standard as *degree* of utility, or of novelty, or of invention. If *novelty, utility* and *invention* exist in the *slightest*

degree, that is sufficient. The importance of the result achieved merely concerns the recompense of the inventor.

II.

That, the patent in question being granted to Beck for inventing a new and useful combination in manifolding sales books, though it be true that the individual elements of the combination are old devices, that does not affect the patentability of the *union* of such alleged old devices for a new and beneficial purpose. The thing must be considered in its *entirety* only. And hereunder :

(a) That there is scarcely a patent granted that does not involve the application of old things to a new use; but the merit consists in being the *first* to make the application, to show how it can be made, and its utility.

(b) That the question is not whether the elements are new, *but whether the combination is new*; that the defendant had the burden of proof to show that a *combination* like the one invented by Beck existed before Beck's invention.

(c) That the fact that the improvement patented to Beck was not in use or known prior to his invention thereof, together with the fact of the ready acceptance and extensive use of the same, when offered to the public, is *strong* evidence that it must have required invention to produce said improvement; otherwise it would surely have been adopted before.

(d) That proof of what *might* have been done cannot be received. The question is what *was* done before. The law will not accept conjecture, but *demand*s certainty.

"Prophecy *after* the event is easy prophecy."

III.

That "utility is suggestive of originality," and that the fact that the Beck manifolding sales book has gone into general use, displacing other books, is strong evidence that the patented im-

provement was the product of an inventive act, *and is sufficient to turn the scale in any question of doubt.* And hereunder :

(a) That the meaning of the word "useful" in the patent law is that the invention shall have *some* beneficial use. The *degree* is immaterial.

(b) That the fact that the defendant used, and his manufacturer made, out of sheer preference, manifolding sales books pirating the Beck invention, is conclusive as against them that they thought the Beck book superior to any other; that infringement is only undertaken when there is utility in the thing infringed.

(c) There is no such test as comparative utility, hence the twelfth finding of the Court on the question of utility implies and assumes an erroneous rule of law; and it is manifest from the record that the trial Court allowed such erroneous rule of law to control its judgment in the premises.

IV.

That there was no evidence produced by the defendant of the existence of any combination remotely resembling the combinations patented to Beck, and the facts found by the Circuit Court are wholly insufficient to support its said conclusion of law, and its said judgment for defendant. And the granting of judgment to defendant on said facts was contrary to the law of the premises.

V.

That the motion of plaintiffs for judgment in their favor on all the facts as proved, and found by the Circuit Court, as of record, should have been allowed, and the denial of such motion by the trial Court was error.

I.

THAT IT IS APPARENT FROM THE FACE OF THE RECORD OF THIS CASE THAT THE TRIAL COURT FAILED TO RECOGNIZE THE FORCE OF THE RULE OF LAW, THAT A PATENT FOR AN INVENTION IS PRIMA FACIE EVIDENCE OF THE EXISTENCE OF ALL THE FACTS ESSENTIAL TO ITS VALIDITY.

In other words, from the grant of the letters patent the law presumes, among other facts, that the subject-matter patented was the product of an inventive act, and the patentee is entitled to the benefit of every doubt.

Robinson on Patents, Vol. 3, Sec. 1016, and cases there cited

In the first blush, the statement of the foregoing rule of law—being so well established—seems unnecessary. We all know it so well that it seems quite preposterous to contend that it was disregarded by the Court below. Yet this fact will be demonstrated. To make myself clear, the position of the plaintiffs is, that the result arrived at by the Court below could not have been reached by any possibility, had the rule of law above stated been applied.

Throughout the contentions to be decided in this case, the following propositions, obvious factors in the judgment of the Court below, must never be lost sight of:

1. That the thing invented by Beck had never before been made, known or used (7th Finding of Fact, Trans., p. 32);
2. That the thing so produced had utility, being immediately adopted and extensively used by the public;
3. That the Court below thought it an uncondonable fault of the thing patented that, as it impressed the Court, it failed to show a *superior degree* of advantage;
4. That on the question of the *degree* of utility, the Court below held to its own views against the weight of the fact of

said acceptance and extensive use, and the expert judgment of the Patent Office ;

5. That, notwithstanding the Court below had found *affirmatively* on the question of the extrinsic *novelty* and *utility* of the thing patented, yet being in *doubt* whether such thing was the product of an *inventive act*, adopted as a rule of law that it must accept the fact of the lack of *superior degree* of utility, which the Court had discerned as conclusive in establishing the lack of the *legal novelty* and patentability of Beck's invention.

With these propositions before us, it is apparent that said presumption of law being given its full weight, no difficulty could have been found in deciding the question of invention involved. It was only when losing sight of this presumption that this case, like any patent case, can be made to assume the complication of the most abstruse theories.

The defendant in error will argue that the presumption of law invoked is disputable. No doubt of that. But let us consider the ordinary import of such presumption. Presumptions of this class we know are the result of general experience; inferring certain facts from the proved existence of another fact. "In this mode the law defines the nature, and the amount of evidence which it deems sufficient to establish a *prima facie* case, and to throw the burden of proof on the other party. . . ." (Greenleaf on Evid., Vol. 1, Sec. 33.)

This class of presumptions "has be^en adopted by common consent, from motives of public policy, and for the promotion of general good." (Ib. Sec. 34.)

Now, in considering this presumption as applied to patents for inventions, let us further examine why patents for inventions, under our system, are *prima facie evidence of the existence of all facts* essential to their validity; why this presumption, as applied to such patents, would promote the general good. In this examination we shall see that the presumption of the validity

of a patent for inventions has not been adopted as a mere *expediency* or *convenience*. No, indeed; much greater import is to be attached to it.

“No patent is issued without an *examination* at the Patent Office by persons *skilled* on the subject. . . . The commissioner is entrusted by law with the power and duty of granting patents for new and useful inventions. He is authorized to grant a patent only for a new and useful invention, or improvement, and it is to be presumed that he has performed his duty.”

Bump on Law of Patents, p. 253, and authorities cited. And see, to same effect, *Union Sugar Refinery Co. v. Matthiesen*, 24 Fed Cases, 686, 688.

In *Cook v. Ernest* (6 Fed. Cases,³⁸⁵ 389) the Court said, while the decision of the Commissioner of Patents, on the question of novelty, “is not entitled to the force of *res adjudicata*, yet it is a determination entitled to the *highest* respect of the Courts and should not be reversed, *except upon the most satisfactory proof.*”

In *Smith, et al., vs. Woodruff*, (22 Fed. Cases, 703.) The Court said: “The Court is greatly relieved, and will be so all the way up to the Court of last resort, by presumptions in favor of the finding by the (Patent) Office, to which is entrusted the determination of the question of patents.”

And when, as in the case, the defendant is unable to produce any anticipating devices, than such as in the very nature of things must have been known and considered by the Examiner of the Patent Office, when he determined that the improvement in question was novel and patentable, then the judgment of the Patent Office is even strengthened, and should be confirmed.

The presumption in favor of the patent on the question of patentable novelty is not of the class in which any trifling, possibly countervailing, evidence will turn the scale, and the burden of proof.

This distinction is well stated in *Untermeyer v. Freund*, 37 Fed. Rep. 343, where the Court, being in doubt, said:

"To state the proposition as fairly as the defendants can expect, the issue upon this branch of the case is involved in uncertainty. If the defendants' right to recover a sum of money in an ordinary action at law depended upon their establishing the affirmative of this issue, a verdict in their favor would, probably, not be disturbed by the Court. *If, however, the complainant's conviction of a crime depended upon the establishment by the prosecution of the same proposition, a verdict of guilty could hardly be sustained.*"

The patent in question was sustained.

See, also, Walker on Patents, Sec. 76. And,

Cluett, et al., v. Clafn, et al. (30 Fed. Rep. ⁹²¹ 922), where the Court said: "A voluminous mass of testimony has been returned upon the question of prior use. The greater part, however, may be laid aside, when it is remembered that this defense must be established by proof as explicit and convincing as that required to convict a person charged with crime; proof which *preponderates* the complainant's testimony *not only*, but which *satisfied the mind* BEYOND a reasonable doubt."

There is another very potent reason for extending to patents for inventions the full effect of the presumption in its favor as above laid down.

Our patent system is based upon a desire to reward those who have a progressive spirit, and devote their energy to improving the conditions of things. The advance made by an inventor must, however, be relatively considered. All inventions are efforts to satisfy some want which is perceived to exist.

"The want may not have been apparent until some previous efforts, partially or imperfectly satisfying the more universal want, disclosed the subordinate and narrower need. Every successive improvement substitutes a better condition of affairs; and at the same time brings to light imperfections still to be overcome.

As the end has become narrower and more special, the scope of the means devised to meet it necessarily becomes correspondingly contracted. Yet it is evident the narrowest and most technical invention which is devised to fill such special want is also entitled to protection."

(Robinson on Patents, Vol. 1, Sec. 88, Note 2.)

Hence, the law "has no nice standard by which to gauge the degree of mental power or inventive genius brought into play in originating the new device. A lucky, casual thought involving a comparatively trifling change often produced decided and useful results, and though it be the fruit of a very small amount of inventive skill, the patent law extends to it the same protection as if it had been brought forth after a lifetime devoted to the profoundest thought and the most ingenious experiments to attain it."

Middleton Tool Co. v. Judd, 17 Fed. Cases,²⁷⁶_A 278.

Robinson on Patents, Vol. 1, Sec. 83.

The magnitude of the result achieved merely concerns the recompense of the invention.

Now, we will instantly agree that this doctrine is sound. But, as soon as it is to be applied to the case before us, a wide gap springs up between the plaintiffs and defendant—a chasm that always did and always will exist on like questions. It is so simple a matter to have widely different opinions on so obviously simple propositions. Thus, note in this case the divergence of the trial judge from the opinion of the Examiner of the Patent Office, who allowed Beck's patent. Both merely acted upon the exhibits of devices so well known to everybody that the conclusion is inevitable, the Examiner had in mind the very same devices claimed to be so suggestive of Beck's invention as to render it unpatentable. This being so, the judgment of the Court below merely overruled the views of the Examiner, and declared unpatentable what the Patent Office had recognized as worthy of such

protection; it could not agree with the Examiner that the change accomplished by Beck was of sufficient importance to grant a patent therefor. The Court had a *doubt*, and instead of resolving its doubt in *favor* of the patent, the Court below resolved its doubt *against* the patent, and held it void.

“No more difficult task is imposed upon the Court in patent causes than that of determining what constitutes invention, and of drawing the line of distinction between the work of the inventor and the constructor. The change from the old structure to the new may be one which one inventor would devise with the expenditure of but little thought and labor, and others would fail to accomplish after long and patient effort. It may be one which one whose mind is fertile in invention will suggest almost instantaneously, when the skilled hand of the constructor will fail to reach the apparently simple result by the long and toilsome process of experiment.” (Pearl v. Ocean Mills, 19 Fed. Cases, pp. 56, 59.)

Hence, now we can see clearly the wholesomeness of the rule of law above referred to, and which is so well stated in the case of Kirby v. Beardsley, 14 Fed. Cases, p.⁶⁵⁴ 660: “This difficulty (distinguishing between invention and construction) in connection with the general merit of inventors, as contributors to the material interest of society has inclined Courts to give a *liberal construction to the law, so as to protect every contrivance that can be called new, that proves at all useful. Care has been taken to give the benefit of doubt, as to originality, or creative thought, to the inventor, so as to nourish inventive enterprise by lending encouragement to every degree of merit.*”

And, to give this beneficial rule of law its full effect, Courts will not allow the presumption of law in favor of patents for inventions to be overcome by proof of the alleged anticipating thing founded on *speculation*. The law will not be satisfied with conjecture, but *demand*s certainty.

Coffin v. Ogden, 18 Wall, 124.

The character of the proof required in cases involving "combinations" will be further considered under following points.

II.

THAT, THE PATENT IN QUESTION BEING GRANTED TO BECK FOR INVENTING A NEW AND USEFUL COMBINATION IN MANIFOLDING SALES BOOKS, THOUGH IT BE TRUE THAT THE INDIVIDUAL ELEMENTS OF THE COMBINATION ARE OLD DEVICES, THAT DOES NOT AFFECT THE PATENTABILITY OF THE UNION OF SUCH ALLEGED OLD DEVICES FOR A NEW AND BENEFICIAL PURPOSE. THE THING PRODUCED MUST BE CONSIDERED IN ITS *ENTIRETY* ONLY.

Beck's invention, as has already been stated, concerned the improvement and the perfection of manifolding books; and one of his objects was "to provide means for manipulating the leaves of the pad without touching the transfer sheet with the fingers." The means by which Beck attained his object have been described and illustrated above. (See *Supra*, p: 3-7)

As we have to examine this invention, the idea of means and mode of operation presented was:

The combination with a manifold-pad of a carbon, or transfer-sheet, possessing the following relative and distinguishing characteristics:

(1) The transfer sheet is so arranged and secured as to normally rest upon the pad, overlying the free ends of the leaves thereof; (2) the carbon sheet has a portion cut away, to expose a corner of the free end of the leaf under it, so that such leaf may be seized by the fingers, at such exposed portion, and withdrawn from under the transfer sheet, without touching the latter with the fingers.

These features are specified in Claims 2 and 3 of Beck's patent as follows:

"2. The combination with a manifold-pad of a holder or cover therefor having a carbon or transfer sheet secured thereto,

said transfer sheet being folded over upon the leaves of the pad at their free ends, and having a portion cut away to expose a portion of the leaves at or near their free ends for the purpose set forth."

"3. The combination, with a manifold-pad, of a carbon or transfer sheet normally resting upon the top of the pad and overlying the leaves thereof, said transfer sheet having a portion cut away to expose a portion of said leaves at or near their free ends for the purpose set forth, the leaves at their free ends being otherwise concealed by the transfer sheet."

The combination comprising the elements of Claim 1 were not in controversy, and should not have been included in the judgment of the Court below at all. The judgment of the Court below should have been confined exclusively to Claims 2 and 3, and the patent left intact as far as Claim 1 was concerned.

The inventive enterprise of Beck being directed to a limited field, more could not be expected than the satisfaction of such wants as such field would disclose. Yet, the simple invention which satisfied that limited want is certainly entitled to protection.

In the old style of manifolding sales books three operations were required in each use of the manifolding pad: First, throwing back the top leaf of the pad covering the carbon sheet; second, *lifting the carbon sheet up*, so as to be able to get at the underlying leaf; third, arranging the underlying leaves. In the Beck improvement the *second* operation was *dispensed* with.

Being obliged to handle the transfer sheet, one would soil the fingers; so here was one undesirable feature overcome. Incidentally, Beck also obtained a most complete, efficient, simple, practical and desirable manifolding sales book. The latter fact is abundantly attested by the ready manner in which the Beck book has been adopted by the general public. Over 500,000 were sold in a single year, even the defendant and his manufacturer falling into line, too.

While Beck in his specification and claims did not confine himself to the particular arrangement shown in the drawing forming a part of his patent application, the latter represent his preferences. Fastening the transfer sheet at the top end, so as to hang down over the pad, is unquestionably the better arrangement. This is the plan followed by plaintiff company in practice, as apparent from the illustration of plaintiffs' Exhibit "B." The infringing books of defendant copied this identical arrangement.

Before the advent of Beck's improvement, the undesirable and awkward second operation of old-style manifolding books was sought to be, and in a measure was, overcome by the construction represented by defendant's Exhibit "A." This was the form in which the manifolding books were made for "*many years*" before the advent of Beck's improvement. (Latter part of Finding No. 7, Trans., p. 32.) This is the book which defendant claimed was just as good as that contrived by Beck. But, what happens when the Beck improvement is placed before the public? The maker of the defendant's just-as-good book, Jarrett, immediately discards it, and pirates the combination devised by Beck. Does the *motive* of Jarrett have to be commented upon?

Now, we are told that the whole invention of Beck was a sham. All Jarrett had to do was just to instruct his workmen to make a book like Beck's and it would be done. But why did he not give such instructions? Because Jarrett did not realize the *susceptibility* of the component parts of a manifolding book *until he had himself been first instructed by the Beck invention.*

Beck's invention was merely an improvement of existing manifolding books, and the improvement was obtained by a *new and useful combination.*

It is to be observed that the defendant, in assailing the novelty of such combination, placed in evidence every imaginable contrivance that could have the remotest bearing on the *factors* of the

combination. But what did it amount to? Did the rigorous search of defendant reveal a carbon sheet in any device, in which it ^{is} ~~functionated~~, as in Beck's book? Is it not manifest from the record of such attempts in this case that, outside of the sphere of manifolding sales books, there was no occasion found for adapting the carbon sheet to functionate as it must in the Beck invention?

The Exhibits "B" and "C" of defendant are mere absurdities, as evidence on the questions involved. A *loose* carbon sheet of any form would be absolutely useless as an element of the Beck combination. And where is the similarity between the function of a carbon sheet having a corner clipped off, so as to facilitate the *separating* of the underlying leaves at any place, and the function of the carbon sheet in the Beck book, facilitating the *withdrawal* of an underlying leaf? In the Beck book, as shown in the drawings, and as copied by the defendant, the cutting away of a portion of the transfer sheet occurs *near its fastened end*.

What have "thumbholes," or their function as used in the indices of ledgers and other books, to do with the question? Yet, these silent, disconnected references of the defendant constitute his whole defense.

"A thing is substantially the same as another if it performs substantially the same function, or office, in substantially the same way to attain substantially the same result; *and things are substantially different when they perform different duties in substantially a different way, or produce a substantially different result.*"

Union Sugar Refinery Co. v. Mathiesen, 24 Fed. Cases, 689, 696.

But what have we to do with all these things, any way? The rule of law governing the patentability of combinations is very clear. "*It will not answer to say the combination required no invention, . . . because . . . any mechanic might have selected the parts and combined them.* The same might be

said, with equal force, in almost every instance in which a patent for a combination is issued." The fact that no one else *did* select and combine the parts and produce a book like Beck's, notwithstanding its apparent utility, as gathered from its immediate and extensive adoption, is a sufficient refutation of the suggestion.

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Dederick v. Cassell, 9 Fed. Rep. 309.

"Where a patent is for a new combination of existing machinery or machines, . . . proof, that *any part* of their structure existed before forms no objection to the patent, for the reason that the invention is *limited* to the combination." Moody v. Fiske, et al., 17 Fed. Cases, 655, 657.

On the same question, the Supreme Court has said (Imhauser v. Bueck, 101 U. S., 647, 660): "Before entering upon a separate examination of these several patents it is proper to remark that it is not pretended that any one of them embodies the *entire* invention secured to the complainant in his letters patent. Nothing of the kind is pretended, but it is insisted that each contains some feature, device or partial mode of operation corresponding in that particular to the corresponding feature, device or partial mode of operation exhibited in the complainant's patent. Suppose that is so, still it is clear that such a concession cannot benefit the respondent, it being conceded that neither of the exhibits given in evidence embodies the complainant's invention, or the substance of the apparatus described and claimed in his specification. Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another prior exhibit, and still another part in a third exhibit, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement."

In Robinson on Patents, Vol. 1, Sec. 155, p. 220, the following rule concerning combinations is laid down and supported by unquestionable authorities:

“While every element remains a unit, retaining its own individuality and identity as a complete and operative means, their *combination* embodies an entirely new idea of means, and thus becomes *another unit*, whose *essential attributes* depend on the *co-operative union* of the elements of which it is composed. . . . Whether the elements are *new or old* . . . is of no importance. To unite them in a *new* means by the exercise of inventive skill is invention, and renders the combination, *as an entirety*, the subject-matter of a patent.”

In Blake v. Stafford (3 Fed. Cases, ⁶¹⁰ 614), Shipman J. said: “Considerable was said on the argument touching the fact that some or all of the elements included in the plaintiff’s combination are old. But this is not material. The question is not whether the *elements* are new, but *whether the combination is new*, . . . though the separate parts are all as old as the art of mechanics. . . . It is needless to remark that originality may be found as well in new combinations of old elements as in the production of new ones.”

Admitting, therefore, that clipping a corner off a carbon sheet is old, and that, of course, the combination of a pad and carbon sheet is old, too, it nevertheless is evident that Beck in his combination obtained an effect never before accomplished in the art of making manifolding sales books; and a much-desired effect, too, no doubt, for was it not imitated as soon as put into practice by Beck?

“If the patentee borrowed the idea of the different parts which go to constitute his invention, and for the first time brought them together, into one whole, and that whole is materially different from any whole that existed before, then he is the original and first inventor, and is entitled to a patent therefor.” Many v. Sizer, 16 Fed. Cases, 685.

And as an answer to a possible argument by the defendant, that the use of a carbon sheet, with a corner clipped off to uncover a portion of the underlying leaf, as in Beck's book, is merely a *new use of an old thing*, and, therefore, not patentable, may be effectively repeated the words of Blatchford D. J. in *Strong, et al., v. Noble* (23 Fed. Cases, 249). The patented invention considered was the use of "a knit fabric for the cover of the handle or other portion of a whip." One of the defenses was that the invention was not patentable, because it appeared that knit fabrics were known and used for various purposes before, and that the application of the same for the purpose of the patentee was merely the application of an old article to a new use. The Court, holding that "the conclusion by no means followed the premises," said: "The first defense set up is that the invention patented is not a patentable invention; that . . . it is merely applying . . . an old article to a new use, in the sense of which, in the law of patents, the mere application of an old article to a new use is held not to be the subject of a patent. Such applications are of this character—using an umbrella to ward off the rays of the sun, it having been before used to keep off the rain; eating peas with a spoon, it having been before used to eat soup with; cutting bread with a knife, it having been before used to cut meat with. To apply the principle here invoked would render void the mass of patents that are now granted. There is scarcely a patent granted that does not involve the application of an old thing to a new use, and that does not, in one sense, fail to involve anything more. But the merit consists in being the first to make the application, and *the first to show how it can be made, and the first to show that there is utility in making it.*" The decree was for the complainant.

Now, this is precisely the argument of the defendant here. They say that, because it is shown that clipped carbon sheets and likewise thumbholes have been previously used for one purpose, there is no patentable difference in their use for any purpose.

In *Forbush, et al., v. Cook*, 9 Fed. Cases, 423-425, Mr. Justice

Curtis in his charge to the jury said: "Some witnesses have testified that in their opinion it did not require invention to devise this combination. Other witnesses have expressed the opposite opinion. The true inquiries for you to make in this connection are whether the combination made . . . was new and useful. If it was new and useful within the meaning of the patent law, it was the subject-matter of a patent, and it is not important whether it required much or little thought, study or experiment to make it, or whether it cost much or little time, or expense, to devise and execute it. If it was a new and useful combination of parts, and he was the first to make the combination, *he is an inventor*, and may have a valid patent. . . . To be new in that sense, some new mode of operation must be introduced. *And it is decisive evidence, though not the only evidence, that a new mode of operation has been introduced, if the practical effect of the new combination is either a new effect or a materially better effect. . . . A new or improved . . . effect, attributable to the change made by the patentee in the mode of operation of existing machinery, proves that the change has produced a new mode of operation, which is the subject-matter of a patent: and when this is ascertained, it is not a legitimate inquiry, at what cost to the patentee, it was made, nor does the validity of the patent depend on an opinion formed AFTER the event respecting the ease or difficulty of attaining it.*"

The test of the inventive act is not its apparent simplicity after having been disclosed, but the prior absence of the means or end attained, though evidently desirable.

In *Hoe v. Cottrell* (1 Fed. Rep., 597,602), Shipman J. said: "In the determination of the question whether there was invention in any particular combination, the important thing is to ascertain whether novelty and utility existed. It is true that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old member to an old set of members; *but, when a*

device has a new mode of operation which accomplishes beneficial results, 'Courts look with favor upon it,' and are not exacting as to the degree of inventive skill which was required to produce the new result."

Now, applying the propositions of law above stated to the case and questions before us: Supposing it to be conceded that manifolding sales books were made prior to the invention of Beck, which were just like the Beck book in all respects, except that the carbon sheet thereof did not have a portion cut away, near its fastened end, for exposing a corner of the upper portion of the underlying leaf of the pad; and supposing, further, that the idea of so cutting away a portion of the carbon sheet was suggested by "thumbholes," and that the susceptibility of a sheet of carbon paper to allow a corner to be so cut away was suggested by another device, be it what it may, it is obvious that neither of these facts has anything to do with the Beck invention. Such invention lay wholly in the particular union, under a particular law of co-operation, to obtain the particular beneficial effect desired. This effect, as has been shown, was the elimination of the annoying finger-soiling and inconvenient time-consuming second operation required in the old style of book; but by means differing from and more practical than those by which such result was attained in the style of book represented by defendant's Exhibit "A." Of course, anybody might have accomplished the same combination of the same parts, and the same beneficial effect as Beck did. The same is true of any kind or class of invention. But the fact is no one did contrive such combination, because they failed to realize and perceive the susceptibility of the individual elements of the old book to adapt them to said new and beneficial result; and Beck being the first to perceive this, to him was lawfully granted his patent therefor.

In *Lee, et al., v. Blandy, et al.* (15 Fed. Cases, ¹⁴²₁₄₄), the Court said that one well-recognized class of patentable combinations was

where "all the parts were before known, and . . . the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result." And see, to same effect, Fuller v. Yentzer, 4 Otto. 288, 296. And Robinson on Patents, Vol. 1, Secs. 155, 156.

The same propositions were again before the United States Supreme Court, in Loom Co. v. Higgins (105 U. S. 591). The Court said: "It is further argued . . . that . . . the devices . . . do not show any invention; . . . that the combination set forth is a mere aggregation of old devices well known, and, therefore, it is not patentable. This argument would be sound if the combination claimed by Webster was an obvious one for attaining the advantages proposed—one which would occur to any mechanic skilled in the art. But it is plain from the evidence, and from the very fact that it was no sooner adopted and used, that it did not for years occur in this light to even the most skilled persons. It may have been under their very eyes—they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice. . . . Now that (the combination) has succeeded, it may be very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule . . . that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention."

III.

THAT "UTILITY IS SUGGESTIVE OF ORIGINALITY," AND THAT THE FACT THAT THE BECK MANIFOLDING SALES BOOK HAS GONE INTO GENERAL USE, DISPLACING OTHER BOOKS, IS STRONG EVIDENCE THAT THE PATENTED IMPROVEMENT WAS THE PRODUCT OF AN INVENTIVE ACT, AND IS SUFFICIENT TO TURN THE SCALE IN ANY QUESTION OF DOUBT.

When we speak of the *utility* of a patented invention, what do we mean?

The definition is concisely given in the case of *Cook v. Ernest*, 6 Fed. Cases, 385, 389:

“All the law requires as to utility is that the invention shall not be frivolous, or dangerous. It does not require any *degree* of utility. It does not exact that the subject of the patent shall be *better* than anything invented before. . . . If the invention is *useful at all*, that suffices. To warrant a patent, the invention must be useful—that is, capable of some beneficial use, in contradistinction to what is pernicious, frivolous, or worthless. . . . The invention should be of *some benefit*. . . . The *degree* is *not pertinent* to the question of the validity of a patent. . . . It is sufficient if the invention have *any* utility.”

The relative value of the patented invention concerns merely the patentee.

See *Robinson on Patents*, Secs. 341, 342, and cases cited.

But, notwithstanding this comprehensive rule, we will nevertheless assume that there are instances in which the utility of an invention, as a basis for a patent, may be comparatively examined with other devices, so as to aid the Court in distinguishing between what utility is the product of mechanical, and what of inventive genius. Where now are we to find a rule that will guide Courts through the maze of doubt? In the first place, we have such rule in the force of the presumption, which, as above explained, attaches to all letters patent for invention regularly granted by the Patent Office, an action which, as we have seen, carries with it the high respect due to the expert judgment of the Patent Office official on the same question. A judgment which, in the case before us, must have been based on the identical information—the exhibits of defendant being common knowledge—as was submitted to the Court when the judgment of the Patent Office was reviewed. The opinion of the expert Examiner of the Patent Office deliberately formed with all the facts before him,

might well be assumed to be at least as good as that of the judge presiding at a trial involving a patent. Invention is purely a mental, intangible process, evidenced in any case solely by the effect obtained.

But assuming, for the sake of argument, that the Court is as much entitled to its opinion as is the Patent Office official; is the property right granted by a patent to be dependent wholly on the uncertainty of human judgment? Is there no further artificial rule which it is safe to follow? Yes, indeed; we have a most wholesome and undisputable rule of law established by the Courts on this very point, and that rule is:

“The utility of the change as ascertained by its consequences is the real practical test of the sufficiency of an invention; and, since the one cannot exist without the other, the existence of the one may be presumed on proof of the existence of the other. Where utility is proved to exist in any degree, a sufficiency of invention to support the patent must be presumed.”

This is the rule laid down in Webster on Patents, p. 30. And in recognizing the force of this rule (in the case of *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486), the United States Supreme Court added:

“We do not say the single fact that a device has gone into general use, and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and *when the other facts in the case leave the question in doubt, it is sufficient to turn the scale.*”

“Utility is suggestive of originality,” and, in the absence of any other test, “the fact of the *acceptance* of a new device or combination by the public, and putting it into extensive use is evidence that it was the product of invention.”

Washburn & Moen Mfg. Co. v. Hais, 4 Fed. Rep.,
900, 907.

But even though the question of the utility of the Beck book could be considered under the obviously erroneous principle of law applied by the Court below, who is the better judge of its utility—the numerous merchants who actually use the book in their business, or the judge who casually considered the same on the trial of this cause, from an indifferent point of view? The merchants who used the Beck book were obliged to give the same a *practical* test in their business. And with what result? Mr. Wilcox says (Trans., p. 36): “With few exceptions the merchants to whom (Beck) books were sold by me have *reordered* the same book.” Can there be any stronger test? If these merchants saw nothing in the Beck book after they had given it one trial, would they have *reordered* the same? Surely, “these circumstances afford a safer criterion of inventive novelty than any subsequent opinion of an expert, or intuition of a judge,” as was remarked by Judge Wallace in *Palmer v. Johnson*, 34 Fed. Rep., 336.

And what about Jarrett, the manufacturer of the infringing book, and the defendant here, the wrongful user thereof? As a proposition of law, they are estopped from denying the utility of the Beck book, because they are actually using it.

Cook v. Ernest, 6 Fed. Cases, pp. 385, 389.

Walker on Patents, Sec. 85, on this subject says: “A patent is *prima facie* evidence of utility, and doubts relevant to the question should be resolved against infringers,” because *it is improbable that men will render themselves liable to actions for infringement unless infringement is useful.*”

If the Beck combination presented such an attraction as to induce defendant and his manufacturer to assume the risk of infringing the same, and yet the improvement was a mere mechanical change, as they would have us believe, why did Jarrett not make the mechanical change before? Why did he have to wait for the suggestion to come from Beck?

The case of Guarantee Trust & Safe Deposit Co. v. New Haven Gas Light Co. (39 Fed. Rep.,²⁶⁸ 272-273) is pertinent to this inquiry. "The inquiry is whether the adaptability of the Siemen's superheater to fix the gas of the Harkness' patent was self-evident to the intelligence of those skilled in the art. If it had been, why was not the substitution made? It introduced very desirable advantages in the process of making illuminating water gas. . . . If the making of this change had been an obvious thing, falling within the range of ordinary mechanical adaptation, it is probable that those skilled in the art would have sought to avail themselves of its advantages. . . . *The fact that the older organizations which it is now claimed were susceptible of being modified by mere mechanical skill into the apparatus of the patent remained without any such modification until the patentee made it, and his improvement when made was so useful and valuable as to commend itself at once to those skilled in the art to which it relates, is sufficient to resolve any doubt whether the improvement embodied invention in favor of the patent.*"

The immediate extensive use of the Beck book is evidence of the highest grade of its superior utility, and that it must have required invention to produce it, otherwise the change of construction involved would long ago have suggested itself. Robinson on Patents, Sec. 344.

The plaintiffs in error venture to say in behalf of the Beck invention that it not only does not require any defense against the apparent reflection of the Circuit Court upon its utility, but that its *superior* utility is vouched for by all the phases of the case. If it were not so, why this stubborn fight by the defendant in error, and Jarrett, the manufacturer? If the style of book which is represented by defendant's Exhibit "A" is really as good as defendant contends, why did he not continue its use, and Jarrett continue its manufacture? and all difficulty would have been avoided. If the patented invention of Beck is of no particular value, that concerns the plaintiffs alone. All they desire is to

quietly enjoy whatever property they may have in such patent, free from the piracy of designing competitors.

The patent of Beck having been granted for a new and useful *combination*, combinations alone concern us. But, as examples of apparently simple inventions which have been litigated, and sustained by the Courts on like issues as here involved, the following cases are cited:

In Ex parte ^{Pennock} (5 Official Gazette, P. 668) the Supreme Court of the District of Columbia, in reversing a decision of the Commissioner of Patents refusing a patent, said: "It is not always safe to consider that there has been no invention because it appears obvious and simple, for simplicity is often the chief merit of a patent."

In the case of Isaac v. Abrams, 13 Fed. Cases, 152, the invention consisted in making a mere change of form in a track broom. The improvement consisted in making the brush of unequal lengths, one part being adapted to brush the surface of the rail, and the longer parts to cleaning either side of the rail. The contention was that brushes with a uniform surface being well known, no invention was required to make one of uneven face—that is, *cutting* away a part of the face of the brush, so as to make a part thereof project beyond the remainder. The Court said: "We cannot take this view of the case. It is not invention to change one well-known material for another, or to apply a well-known process without some adaptation, more than every skilled mechanic could apply, to a new art or subject; but a *change in form* of a machine or instrument, *though slight*, if it works a successful result, not before accomplished in a similar way in the art to which it is applied, or in any other, is *patentable*. There is evidence that this improvement did accomplish such result, and that it was accepted and adopted by the trade, and went into general use." Decree for complainant.

In Washburn & Moen Mfg. Co. v. Haish, 4 Fed Rep., 900, 907, the patent tested was for an improvement in barbed fence

wire. Commenting on the same, the Court said: "The testimony as to the state of the art shows that fence wire, and wire fence, and wire for such purposes composed of two or more strands twisted, or laid together, were old at the time these inventors entered the field; also, that fences had been long before Hunt's invention armed with spikes, or other sharp, projecting points for the purpose of making them more effective in resisting the encroachments of animals and other intruders. Indeed, the thorn hedges which have been used almost from time immemorial are in one sense only a barb fence, their effectiveness as a barrier arising mainly from the natural thorn, or spurs, with which the hedge shrubs are armed. It must be conceded, both from the proofs in these cases, and from the common facts within the knowledge and observation of all intelligent persons, that the idea of furnishing a fence or wall with some kind of sharp spikes, or prickers, is old. . . . The most that can be said of these old devices as applicable to these patents is that the narrow field for the exercise of inventive faculty limits the range of patents. In this connection it is proper to consider briefly the objection that these devices are not patentable from the fact that, in view of what was well known in the same direction, it did not require inventive genius to make any of the devices involved in these patents, but that only mechanical skill was requisite to adapt old devices to this new one. There is no doubt that the device, in order to be patentable, must be the result of inventive genius. The mere mechanical adaptation of old things to new uses is not usually invention, unless in combinations, and yet it is extremely difficult in many cases to say just where the inventive faculty exercises itself as the controlling force. . . . If there is any invention required, then the law will not attempt to measure its extent or degree. If, for instance, the proof had shown that wire provided with barbed spurs, or prickers, was a well-known article used for other purposes than fencing, there would be no difficulty in saying that it did not require invention, or the exercise of inventive faculty to

substitute it for fencing purposes in place of plain wire, which had been used before. But we cannot say that the inventive, or creative, faculty is not required in devising a mode by which plain wire can be armed with spurs, so as to make it available as an effective fencing material. The proof does not show that such wire was known and applied to other uses." The decree was entered in favor of the complainants.

In *Howe v. Underwood*, 12 Fed. Cases, 67⁸₉, 685, the Court said: "After having seen what has been done, the mind is very apt to blend the subsequent information with prior recollections, and confuse them together. Prophecy after the event is easy prophecy. I think that this is one of the cases in which several of the witnesses have been led into the illusion of believing that they knew before what they have learned or been taught by Mr. Howe's invention and specification."

In the present case these were not even witnesses who testified for the defendant. The fact of alleged anticipation was left to conjecture of what might or could have been done. But the Circuit Court has evidently committed the very errors against which the foregoing is an admonition. How simple it all seems when we are told how it is done! But Beck did not have any one to tell him.

In *Cook, et al., v. Ernest, et al.* (6 Fed Cases, 385), the patented invention was for an "improvement in metallic ties for cotton bales." It related to a means for facilitating the securing of one of the turned-back or looped ends of a metallic hoop or band for tying a bale of cotton. This fastening device is illustrated below:



It consisted of a plate comprising three transverse slots and consequently leaving four transverse bars, or bridging solid por-

tions. The ends of the bands were inserted through the slots, over the bars, and secured as shown. "To avoid the necessity of thrusting the end of the band under the fourth bar, I, the patentee, cut a slit, or opening, H, . . . so that the band, when the slack was fully taken up, and the end was bent over to form the final fastening, could be passed sidewise through the opening into the slot and under the fourth bar, so as to effect the fastening with greater facility and rapidity." (This statement is taken from *McComb, et al., v. Brodie*, 15 Fed. Cases, 1291, to which the opinion in the case above cited refers.) On an application for a preliminary injunction, Woods Cir. J. said: ". . . To warrant a patent the invention must be . . . capable of some beneficial use. . . . The degree of utility is not pertinent to the question of the validity of the patent. . . . If the defendant has used the patented improvement, he is *estopped* from denying its utility. . . . Tested by these rules, the defense of want of utility is clearly untenable. . . . The next defense . . . is the want of novelty. . . . The issue of letters patent is *prima facie* evidence that the patentee was the first and original inventor. . . . The decision of the Commissioner of Patents is entitled to the highest respect of the Courts, and should not be reversed except upon the most satisfactory proof. . . . *Upon the issue of novelty, testimony will not be received to show what MIGHT have been done with previous machines.*" *Howe v. Underwood* (12 Fed. Cases, 699, 685.) It is not enough to defeat the novelty of an invention, that prior contrivances are produced which *might*, with a *little change*, have been made into the patented contrivance, *though not so intended by the maker.* *Livingstone v. Jones* (15 Fed. Cases, 666). Changes in the construction and operation of an old machine, so as to adapt it to a new and valuable use, which the old machine had not, are patentable, and may consist either in a material modification of old devices, or in a new and useful combination of the several parts. *Seymour v. Osborne* (11 Wall. 516). The link presented by the affidavits of Wallis and others is an elongated open ring. It is similar to

a device long used for attaching the clevis of a plow to the double-tree, and . . . by farmers for lengthening traces or other chains. The pretense that the prior use of this open link shows want of novelty in Cook's third claim (which covered the slot H in the bar I) is untenable. *It is a device designed to accomplish no such purpose as Cook's device, and is not adapted to that end.*" The next exhibit for defendant evidently was a shoe buckle, also having an *open slot*. Concerning this the Court continued: "An examination . . . shows that it was not intended as a fastening for metallic ties, or bands, and that it is so constructed that a metallic band cannot be introduced sidewise through the open slot in the buckle. This, therefore, cannot be claimed as . . . embodying the same principle as Cook's." The injunction was allowed.

The analogy between the "slot" in the "shoe-buckle" in the case last cited, and the "clipped carbon" and "thumbholes" in the case before us is too plain to require comment.

In *Lorillard & Co. v. eDowell & Co.* (15 Fed. Cases, 893, and followed in *Lorillard v. Carroll*, 9 Fed. Rep. 509), the invention consisted of tags for marking or distinguishing tobacco in plugs. The tags were cut out of tinned sheet iron, and were of circular form with prongs bent back from their edges, and with marks upon their faces to indicate quality, origin, etc. The tags were placed on the tobacco and by a powerful press the prongs were sunk into the tobacco. The Court said on the question of lack of patentable novelty: "Simple as it is, it, nevertheless, involved reflection and experiment to bring it to practical maturity, and is evident utility indicated by its prompt displacement of other identifying devices, and its very extensive use, even by the respondents, strongly attests its patentable merit." Motion for injunction allowed.

IV.

THAT THERE WAS NO EVIDENCE PRODUCED BY THE DEFENDANT OF THE EXISTENCE OF ANY COMBINATION REMOTELY RESEMBLING

THE COMBINATIONS PATENTED TO BECK, AND THE FACTS FOUND BY THE CIRCUIT COURT ARE WHOLLY INSUFFICIENT TO SUPPORT ITS SAID CONCLUSION OF LAW, AND ITS SAID JUDGMENT FOR DEFENDANT. AND THE GRANTING OF JUDGMENT TO DEFENDANT ON SAID FACTS WAS CONTRARY TO THE LAW OF THE PREMISES.

What is there in the Findings of Fact to uphold the conclusion of law and judgment of the Circuit Court that the patent issued to Beck for his combination is void, for lack of novelty? The Court found the combination was new and that it was actually in use; and the defendant was unable to present any like combination.

The conclusion of the Circuit Court, therefore, is clearly erroneous.

V.

THAT THE MOTION OF PLAINTIFFS FOR JUDGMENT IN THEIR FAVOR ON ALL THE FACTS AS PROVED, AND FOUND BY THE CIRCUIT COURT, AS OF RECORD, SHOULD HAVE BEEN ALLOWED, AND THE DENIAL OF SUCH MOTION BY THE TRIAL COURT WAS ERROR.

The ultimate facts found by the Circuit Court are: That the combination invented by Beck was new and original; that it was capable of, and had actually been put to practical and beneficial use; that it was an improvement of such merit as to cause the defendant, and his manufacturer, to discard all previous books, and to imitate said improvement. On these facts the Circuit Court could arrive at but one conclusion, and that was, that the patent of Beck is valid, and that it has been infringed by defendant; and its judgment should have been accordingly for the plaintiffs.

This is a test case. It is the only way open to the plaintiffs to substantiate their patent. But the mere use of infringing books by defendant is not the plaintiffs' gravamen. It is evident that the defendant in error is either allowing himself to be used as a "cat's-paw" or a dummy for the manufacturer,

Jarrett. Otherwise, there would not have been this litigation. And as to Jarrett, his motive is quite apparent. He seeks, in the attempt to belittle and scoff at the ingenuity and originality of Beck, his only escape from the consequences of his unlawful act.

The judgment of the Court below should be reversed, and the case remanded with instructions on the law of the premises, in order that the plaintiffs may have justice.

Respectfully submitted,

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